



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.                | CONFIRMATION NO.            |
|--|-------------|----------------------|------------------------------------|-----------------------------|
| 10/596,703   | 06/22/2006  | Anthony Morel        | BWAC-30542                         | 9744                        |
| 27883  | 7590        | 05/21/2010           |                                    |                             |
| GRADY K. BERGEN<br>3333 LEE PARKWAY<br>SUITE 600<br>DALLAS, TX 75219 |             |                      | EXAMINER<br>MCCORMICK, GABRIELLE A |                             |
|  |             |                      | ART UNIT<br>3629                   | PAPER NUMBER                |
|  |             |                      | NOTIFICATION DATE<br>05/21/2010    | DELIVERY MODE<br>ELECTRONIC |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

MAIL@INVENTLEGAL.COM  
MAIL@GKBERGENLAW.COM



## **DETAILED ACTION**

### ***Status of Claims***

1. This action is in reply to the amendment filed on April 28, 2010.
2. Claims 17-26 have been added.
3. Claims 1-16 have been canceled.
4. Claims 17-26 are currently pending and have been examined.

### ***Claim Objections***

5. Claims 17 and 26 are objected to for using the article "an" to precede "user profile. The correct article is "a".
6. Previous objections are moot as claims 1-16 are cancelled.

### ***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
8. Claims 25 and 26 contain numerous means (or step) plus function limitations that invoke 35 U.S.C. 112, sixth paragraph. However, the written description fails to disclose the corresponding structure, material, or acts for the claimed function. The specification and figures only refer to the system as a collection of "means" (see figures 1 and 2). It is unclear from the specification whether the "means" are software applications.
9. Applicant is required to:

(a) Amend the claim so that the claim limitation will no longer be a means (or step) plus function limitation under 35 U.S.C. 112, sixth paragraph; or

(b) Amend the written description of the specification such that it expressly recites what structure, material, or acts perform the claimed function without introducing any new matter (35 U.S.C. 132(a)).

10. If applicant is of the opinion that the written description of the specification already implicitly or inherently discloses the corresponding structure, material, or acts so that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function, applicant is required to clarify the record by either:

(a) Amending the written description of the specification such that it expressly recites the corresponding structure, material, or acts for performing the claimed function and clearly links or associates the structure, material, or acts to the claimed function, without introducing any new matter (35 U.S.C. 132(a)); or

(b) Stating on the record what the corresponding structure, material, or acts, which are implicitly or inherently set forth in the written description of the specification, perform the claimed function. For more information, see 37 CFR 1.75(d) and MPEP §§ 608.01(o) and 2181.

11. As a result of Applicant's cancellation of claims 1-16, the previous rejections are withdrawn.

### ***Claim Rejections - 35 USC § 101***

12. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

13. Claims 17-26 are rejected as being directed to non-statutory subject matter. Claims 17 and 21 are method claims that recite process steps that are not tied to a particular machine. Based on recent Federal Circuit decision (see *In re Bilski*), an applicant may show that a process claim satisfies 35 USC 101 either by showing that his claim is tied to a particular machine, or by showing that his claim transforms an article. (See Benson, 409 U.S. at 70). First, as illustrated by Benson, the use of a specific machine or transformation of an article must impose meaningful

Art Unit: 3629

limits on the claim's scope to impart patent-eligibility. (See Benson, 409 U.S. at 71-72). Second, the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity. (See Flook, 437 U.S. at 590).

14. Although the preambles of claims 17 and 21 refer to an apparatus, structural elements solely recited in the preamble are not accorded patentable weight. To overcome this rejection, the structural elements should be recited as part of the body of the claim.
15. Because the applicable test to determine whether a claim is drawn to a patent-eligible process under 35 USC 101 is the machine-or-transformation test set forth by the Supreme Court, claims 17 and 21 fail that test and are therefore rejected under 35 USC 101.
16. Claims 25 and 26 are rejected under 35 U.S.C. 101 because they lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 36 USC 101. As discussed above with respect to 35 USC 112, the "means for" steps may be understood to comprise software applications. As such, they are clearly not a series of steps or acts (i.e., a process) nor are they a combination of chemical compounds (i.e., composition of matter). As such, they fail to fall within a statutory category. They are, at best, function descriptive material *per se*.
17. Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." Both types of "descriptive material" are nonstatutory when claimed as descriptive material *per se*, (33 F.3d at 1360, 31 USPQ2d at 1759). When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994).
18. Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm

Art Unit: 3629

in *Benson* were unpatentable as abstract ideas because “[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.”).

### ***Claim Rejections - 35 USC § 103***

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. **Claims 17-20 and 25** are rejected under 35 U.S.C. 103(a) as being unpatentable over Herz (US Pat. No. 6,029,195) in view of Linden et al. (US Pat. No. 6,266,649, hereinafter referred to as “Linden”).

21. **Claims 17 and 25:** Herz discloses

- Receiving content information including a particular information characteristic (C4; L51-53: target object profile with attributes)
- Matching said content information with a user profile to obtain a comprehensive degree of interest (C19; L29-31)
- Obtaining an alert characteristic and determining a comprehensive alert level based on parameters of the alert characteristic (C13; L19-23: numeric evaluations from MPAA is alert characteristic; C10; L58-60: alert level is determined (“0=G, 1=PG,...”))
- Weighting by the comprehensive alert level (C22; L15-44: each attribute is weighted to specify importance; user assigns a “vulgarity score”)
- Recommending corresponding information to the user according to the weighted comprehensive degree of interest. (C7; L8-18 and C22; L29-44)

22. In Herz, the weighting is performed as part of the generation of the comprehensive degree of interest.

Art Unit: 3629

- 23.** Linden discloses that a similar items lists (i.e., a list of potentially recommendable objects) is weighted by multiplying the commonality index value by a weighting value to produce "scores". The list is then filtered to remove unwanted items based on a content rating (such as PG or adult). (C11; L16-37). Thus, Linden discloses the step of weighting after a first calculation is made based on the content of the objects.
- 24.** Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included weighting objects after performing a first calculation, as disclosed by Linden in the system disclosed by Herz, for the motivation of providing a method of enabling filtering based on the weighted "vulgarity score" disclosed by Herz.
- 25. Claims 18, 19 and 20:** Herz discloses particular program information and keywords (C11; L8-26) and alert characteristics including age (C10; L60) and vulgarity (C22; L40-44).

### ***Allowable Subject Matter***

- 26.** Claims 21-24 and 26 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 101, and additionally for claim 26, 35 U.S.C. 112, 2nd paragraph, as set forth in this Office action.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 3629

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gabrielle McCormick whose telephone number is (571)270-1828. The examiner can normally be reached on Monday - Thursday (5:30 - 4:00 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/G. M./  
Examiner, Art Unit 3629

/JOHN G. WEISS/  
Supervisory Patent Examiner, Art Unit 3629